

a) Claim Rejection Based On Gallagher In View Of Moss

The rejection of Claims 21-26, 31, 35, 38-40, 48-49, 53-54 and 56-58 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) as anticipated by or obvious over U.S. Patent 5,171,308 ("Gallagher") in view of U.S. Patent 4,698,372 ("Moss") is respectfully traversed.

Individually or in combination Gallagher and Moss do not disclose or suggest all the elements and limitations of independent Claims 21, 50 and 53. For example, the references do not disclose the limitations requiring the biodegradable thermoplastic polymers to be selected from the group consisting of polylactic acid polymers; polyester terpolymers of butanediol, adipic or succinic acid, and terephthalic acid; polycaprolactone polymers; and combinations thereof.

Gallagher which is cited by the Examiner as the anticipating reference and the primary obviousness reference in this rejection clearly teaches away from applicants' polymers on column 2, lines 34-40:

Various polyester compositions have been suggested in the past for biodegradable end uses. These include polyhydroxybutyrate, polylactide, polycaprolactone, polyglycolide, and their copolymers. They have not been widely adopted in high volume uses, however, because they are either too expensive or their properties are inadequate for the uses mentioned above.

The polylactic acid polymers and polycaprolactone polymers of the Applicants' invention have suitable properties for use in the film and nonwoven web layers of a breathable outer cover laminate. These are bulk commodity products requiring high volumes of polymer. Gallagher plainly teaches that the claimed polymers are too expensive or inadequate for these uses.

Compostable polyesters are disclosed in Gallagher but the reference does not teach or suggest the use of diols and specifically the use of butanediol for a terpolymer with adipic or succinic acid and terephthalic acid. The Examiner has found no suggestion in the cited reference to substitute the Applicants' biodegradable thermoplastic polymers for those disclosed in Gallagher that are clearly specified therein. Gallagher places great emphasis on the specified polyester formulations requiring alkali metals or alkaline earth metal sulfano groups. The substitution of polymers proposed by the Examiner can only be based on improper hindsight. Where Gallagher emphasizes the use of its own polymers, it

would not be obvious to arbitrarily substitute applicants' distinctly different polymers. Put another way, by teaching toward the use of only specific biodegradable polymers (as opposed to others) for the disclosed applications, Gallagher explicitly or implicitly teaches away from the use of other biodegradable polymers including those claimed by Applicants in independent Claims 21 and 50. Regarding independent Claim 53, Gallagher does not disclose a breathable outer cover laminate in which every film layer and the fibrous nonwoven web are formed of biodegradable polymer.

Moss is cited by the Examiner for teaching biaxial stretching as recited in Claims 48-49. Moss does not teach or suggest Applicants' above cited biodegradable thermoplastic polymer of independent Claim 21 or 50. Since neither individually Gallagher nor Moss teach or suggest Applicants' polymer, the combination of Gallagher and Moss do not teach or suggest Applicants' polymer. Regarding Claim 53, Moss does not disclose a breathable outer cover laminate in which every film layer and the fibrous nonwoven web are formed from a biodegradable polymer. The combination of the cited references has not provided all the limitations of the claimed invention. Therefore, the Examiner has not met the requirements for a *prima facie* case of obviousness. Accordingly, this claim rejection should be withdrawn.

MPEP § 2143 sets out three requirements for a *prima facie* case of obvious: 1) a suggestion to combine, 2) an expectation of success, and 3) disclosure of all the limitations. The Examiner has not provided a suggestion to combine the prior art references to arrive at the claims. The Examiner also has not provided an expectation of success, especially given the contrary teachings of the primary reference. The requirements for obviousness are not met where the prior art, taken as a whole teaches away from one or more claim limitations. See MPEP §2141.02, §2143.01 and cases cited therein. Finally, neither Gallagher, nor Gallagher combined with Moss, disclose all the limitations of the Applicants' independent claims. Therefore, the Examiner has failed to meet any of the requirements for a *prima facie* case of obviousness.

For at least these reasons, Applicants' invention is distinguished from Gallagher and is nonobvious over Gallagher. Accordingly, this claim rejection should be withdrawn.

b) Claim Rejection Based On Gallagher In View Of Moss And In Further View of McCormack

The rejection of Claims 41, 44-47 and 50-52 under 35 U.S.C. § 103(a) as obvious over Gallagher in view Moss and in further view of U.S. Patent 5,955,187 ("McCormack") is respectfully traversed. These claims depend from Claim 21 or 50 and are patentable for at least the same reasons and the following additional reasons.

McCormack is cited by the Examiner for teaching water swellable filler materials, applications of the laminate and composition ranges as recited in Claims 41, 44-47 and 50-52. McCormack does not teach or suggest Applicants' above cited biodegradable thermoplastic polymer of Claims 21 and 50 from which Claims 41, 44-47 and 50-52 depend therefrom. The combination of the cited references has not provided all the limitations of the claimed invention. Also, as explained above, the primary reference (Gallagher) teaches away from using all but certain specific polymers and teaches away from Applicants' claimed polymers. Therefore, the Examiner has not met the requirements for a *prima facie* case of obviousness. Accordingly, this claim rejection should be withdrawn.

c) Claim Rejection Based On Gallagher In View Of Moss And In Further View of Borgher or Trinh

The rejection of Claims 42-43 under 35 U.S.C. § 103(a) as obvious over Gallagher in view Moss and in further view of U.S. Patent 5,139,678 ("Borgher") or U.S. Patent 5,968,404 ("Trinh") is respectfully traversed. Claims 42-43 depend from independent Claim 21 and are patentable for at least the same reasons and the following additional reasons.

The Examiner cites Borgher or Trinh to allegedly teach the use of cyclodextrin as a filler material in a plastic film. However, Borgher actually teaches the use of cyclodextrin/perfume complexes on a dryer sheet. Trinh actually teaches the use of cyclodextrin in fabric freshening solutions. The combination of these references clearly do not teach or suggest applicants' use of cyclodextrin as a filler material embedded within a matrix of a biodegradable thermoplastic polymer film layer of a breathable outer cover laminate.

The combination of the cited references has not provided all the limitations of the claimed invention. Therefore, the Examiner has not met the requirements for a *prima facie* case of obviousness. Accordingly, this claim rejection should be withdrawn.

d) Claim Rejection Based On Gallagher In View Of Moss And In Further View of Chandler

The rejection of Claim 37 under 35 U.S.C. § 103(a) as obvious over Gallagher in view Moss and in further view of U.S. Patent 6,028,160 (“Chandler”) is respectfully traversed. Claim 37 depends from independent Claim 21 and is patentable for at least the same reasons and the following additional reasons.

Chandler does not teach a breathable outer cover laminate, comprising: a breathable, stretch-thinned barrier film having one or more layers; one of the layers including a mixture of filler particles and a biodegradable thermoplastic polymer, having voids formed around the filler particles to facilitate passage of water vapor through the film, and constituting 50-100 % of a thickness of the film; each of the layers including a biodegradable thermoplastic polymer; and a fibrous nonwoven web continuously adjacent to laminated face to face with the film and including a biodegradable thermoplastic polymer. Furthermore, as explained above, the primary reference (Gallagher) teaches away from all but certain specific polymers, and teaches away from the polymers recited in Applicants’ Claim 21. Gallagher teaches away from the polymers disclosed in Chandler (see Gallagher column 2, lines 34-40). Therefore, the cited references cannot be combined to arrive at the claimed invention. See MPEP §2143.01 and cases cited therein. The Examiner has not met the requirements for a *prima facie* case of obviousness. Accordingly, this claim rejection should be withdrawn.

e) Conclusion

Applicants believe that the above arguments are persuasive and that the claims, as presented, are in condition for allowance. If the Examiner detects any unresolved issues, then Applicants' attorney respectfully requests a telephone call from the Examiner, and a telephone interview. Applicants respectfully request issuance of a Notice of Allowance.

Respectfully submitted,



Maxwell J. Petersen
Registration No. 32,772

Pauley Petersen & Erickson
2800 West Higgins Road
Suite 365
Hoffman Estates, Illinois 60169
TEL (847) 490-1400
FAX (847) 490-1403